

ESTTA Tracking number: **ESTTA373828**

Filing date: **10/18/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052698
Party	Defendant AmeriCareers, LLC
Correspondence Address	DAN OUYANG AMERICAREERS, LLC 5000 NORTHWIND DR STE 218 EAST LANSING, MI 48823 UNITED STATES ouyangda@msu.edu
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Jeffrey M. Furr
Filer's e-mail	jeffmfurr@furrlawfirm.com
Signature	/jmf/
Date	10/18/2010
Attachments	counterclaim_amd1fin.pdf ( 5 pages )(17806 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Internet Employment Linkage, Inc. d/b/a  
HigherEdJobs

Petitioner,

v.

AmeriCareers, LLC

Registrant.

Cancellation No.: 92052698  
Registration No.: 3,666,461  
Trademark: **HIGHER ED SPACE**  
Registered on: August 11, 2009  
Registered by: AmeriCareers LLC

and

AmeriCareers, LLC

Counterclaim Plaintiff,

v.

Internet Employment Linkage, Inc.

Counterclaim Defendant.

Counterclaim Petition to Cancel  
Registration Nos.: 2688003 and 2781127  
Trademarks:  
**HigherEdJobs.com** (Registration No.  
2,688,003) was issued on: Feb. 18, 2003  
**HigherEdJobs.com** (Registration No.  
2,781,127) was issued on: Nov. 11, 2003.  
Registered by: Internet Employment  
Linkage, Inc.

**FIRST AMENDED  
COUNTERCLAIM PETITION TO CANCEL**

Registrant and Counterclaim Plaintiff, AmeriCareers LLC (“AmeriCareers”), through its undersigned attorney, moves to amend Registrant’s Counterclaim Petition to Cancel Petitioner and Counterclaim Defendant, Internet Employment Linkage Inc.’s (“IELI”) trademark registration for the mark “HigherEdJobs.com” (Reg. No. 2,688,003), and trademark registration (Reg. No. 2,781,127) with an alternative to amend the

registration (Reg. No. 2,781,127) by inserting a disclaimer of the term “HigherEdJobs.com”.

AmeriCareers LLC, a Michigan limited liability company having a principal place of business at 5000 Northwind Dr., Suite 218, East Lansing, Michigan 48823, believes that it is or will be damaged by Registration Nos. 2,688,003 and 2,781,127, and herein petitions to cancel the same.

To the best of AmeriCareers’ knowledge, Internet Employment Linkage Inc. (“IELI”), having a principal place of business in Oak Park, Illinois 60301 is the current owner of Registration Nos. 2,688,003 and 2,781,127. Description of IELI’s registrations: “HIGHEREDJOBS.COM” (Registration No. 2,688,003) filed on March 30, 2001 and registered on February 18, 2003 on the Principal Register in International Class 035 for “Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data [ related data ] related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty.” claiming its first use on December 10, 1996 and its first use in commerce on December 10, 1996. “HIGHEREDJOBS.COM” and DESIGN (Registration No. 2,781,127) filed March 30, 2001 and registered on November 11, 2003 on the Principal Register in International Class 035 for “Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools,

institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty.” claiming its first use on December 01, 1999 and its first use in commerce on December 01, 1999.

As grounds of this Counterclaim Petition, it is alleged that:

1. In IELI’s Marks, “HigherEdJobs.com”, is generic as it consists primarily of the term “higher ed jobs”., which generically refers to Personnel placement and recruitment services for academic professionals and faculty and all associated services. In particular, “higher ed jobs”, or “higher education jobs”, is a common term used to name, describe or categorize the entire class of jobs in the field of higher education. When referred to a service, the term “higher ed jobs”, or “higher education jobs”, generically refers to employment, personnel recruitment, placement services, or related information and resources in the academic field. The term “higher ed jobs” is widely used in the field for the above-mentioned services. Furthermore, the top-level domain (TLD) “.com” merely indicates an Internet address for use by commercial, for-profit organizations and, in general, adds no source identifying significance.
2. AmeriCareers has been and will continue to be damaged by the continued existence of Registration No. 2,688,003 and Reg. No. 2781127 based upon the merely generic nature of the Registered Mark as applied to its services and IELI’s Cancellation Proceeding No. 92052698 filed against AmeriCareers based on these marks.

3. Based on the above, the trademark registration, Reg. No. 2688003, should be cancelled, pursuant to Section 14 of the Trademark Act. [15 U.S.C. §1064 (3)].
4. Based on the above, the trademark registration, Reg. No. 2781127, which contains both words and design should be cancelled due to the genericness of the word part of the mark for “HigherEdJobs.com”. In the alternative, the registration (Reg. No. 2781127) should be amended to insert a disclaimer of the term “HigherEdJobs.com”.

WHEREFORE, in pursuant to Section 14 of the Trademark Act. [15 U.S.C. §1064 (3)], the Counterclaim Plaintiff, AmeriCareers, prays:

5. That this Counterclaim Petition to Cancel be sustained.
6. That the trademark registration, Registration No. 2688003, be cancelled.
7. That the trademark registration, Registration No. 2781127, be cancelled, and that in the alternative, Registration No. 2781127 be amended to insert a disclaimer of the term “HigherEdJobs.com”.

Date: 10/18/2010

Respectfully submitted,

By: /jmf/

JEFFREY M. FURR  
FURR LAW FIRM  
2622 DEBOLT RD  
UTICA, OH 43080  
JeffMFurr@FurrLawFirm.com  
Counsel for Registrant and Counterclaim Plaintiff

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing document is being deposited with the United States Postal Service with sufficient postage as first class mail, on the date set forth below in an envelope addressed to:

ELIZABETH R. BURKHARD  
HOLLAND & KNIGHT LLP  
10 ST. JAMES AVENUE, 11TH FLOOR  
BOSTON, MA 02116

Date: 10/18/2010

By: /jmf/